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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/954,737	09/17/2001	Sierd Bron	GC634-2	7663
5100	7590	03/07/2006	EXAMINER	
GENENCOR INTERNATIONAL, INC. ATTENTION: LEGAL DEPARTMENT 925 PAGE MILL ROAD PALO ALTO, CA 94304			BURKHART, MICHAEL D	
			ART UNIT	PAPER NUMBER
			1633	

DATE MAILED: 03/07/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/954,737

Applicant(s)

BRON ET AL.

Examiner

Michael D. Burkhardt

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on 15 December 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 3-11 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 3-6 is/are allowed.
- 6) ☒ Claim(s) 7-11 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Receipt and entry of the amendments dated 3/8/2004, 5/26/2005, 9/6/2005, and 12/15/2005 is acknowledged. After entry of the amendments, claims 3-11 are pending and under examination.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 7-11 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. **This is a new rejection necessitated by applicants' amendments to the claims.**

Claims 7-11 are rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential steps, such omission amounting to a gap between the steps. See MPEP § 2172.01. The omitted steps are: providing for the *B. subtilis* TatAd/Cd protein in the claimed host cell or bacteria. The claimed host cells and bacteria are not limited to *B. subtilis*, but rather encompass the use of any host cell (e.g. bacterial, yeast, mammalian, insect, etc.). It is disclosed that in order for a polypeptide comprising the *B. subtilis* PhoD signal sequence to be secreted from a heterologous host cell such as *E. Coli*, *B. subtilis* TatAd/Cd must also be expressed. See pages 32-33 of the specification.

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it

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pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claim 7-11 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for embodiments wherein the host cell is a bacterial cell overexpressing the *B. subtilis* TatAd/Cd proteins and wherein the PhoD signal sequence is the *B. subtilis* PhoD signal sequence, does not reasonably provide enablement for any other embodiments. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the invention commensurate in scope with these claims. **This rejection is maintained for reasons of record and for reason outlined below.**

Response to Arguments

Applicant's arguments filed 3/8/2004 have been fully considered but they are not persuasive. Applicants present no specific arguments regarding the outstanding enablement rejection, other than that the claims have been amended. However, the scope of the claimed host cells has not been amended, and remains much broader than that for which the specification is enabling. The claims embrace literally any host cell, therefore the claimed *B. subtilis* PhoD signal sequence must direct protein secretion in a broad genus of host cells in order to be commensurate in scope with the claimed subject matter. This is clearly not the case, as the specification teaches only *B. subtilis* as a suitable host for the claimed methods. Upon modification to express *B. subtilis* TatAd/Cd proteins, *E. Coli* was also found to be a suitable host cell for protein secretion mediated by the *B. subtilis* PhoD signal. See pages 7-10 of the previous Office Action (dated 11/5/2003) and pages 32-33 of the specification. Therefore, the instant specification is only found to be enabling for embodiments directed to bacterial cells

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wherein the *B. subtilis* PhoD signal sequence (i.e. Table 1) and *B. subtilis* TatAd/Cd proteins are used to mediate secretion of the desired protein sequence.

Conclusion

Claims 3-6 are allowed.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a).

Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael D. Burkhart whose telephone number is (571) 272-2915. The examiner can normally be reached on M-F 8AM-5PM.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dave Nguyen can be reached on (571) 272-0731. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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Michael D. Burkhart
Examiner
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A handwritten signature in black ink, reading "Scott D. Priebe". The signature is written in a cursive style with a large, stylized "S" and "P".

SCOTT D. PRIEBE, PH.D
PRIMARY EXAMINER